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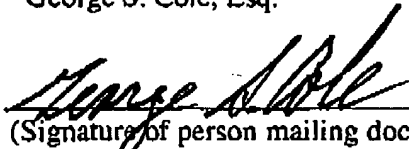
I hereby certify that the following documents:

- attorney's cover letter;
  - a copy of the Office Action;
  - Response to the Office Action;
  - Claims Listing;
- and,
- a copy of this Express Mail Certificate;

are being deposited in a single envelope with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and such envelope is addressed to:

**Mail Stop AF**  
Attn: Examiner Andre Boyce  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450.**

George S. Cole, Esq.

  
(Signature of person mailing documents)

George S. Cole, Esq.  
495 Seaport Court, Suite 101  
Redwood City, CA 94063

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**To:** US Patent and Trademark Office  
Attn: Examiner Andre Boyce

**Recipient's Fax:** 571-273-8300

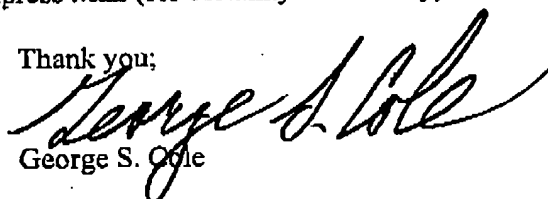
**From:** George S. Cole, Esq.

**Recipient's Phone:** 571-272-6726

Dear Examiner Boyce:

This After-Final Response is being sent by both Fax (to make it immediately accessible to you) and by Express Mail (for certainty of delivery).

Thank you;



George S. Cole



# UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/476,711      | 12/30/1999  | DAVID O. MCGOVERAN   |                     | 8198             |

7590 08/18/2006  
 GEORGE S COLE  
 495 SEAPORT COURT SUITE 101  
 REDWOOD CITY, CA 94063

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|                |              |
|----------------|--------------|
| EXAMINER       |              |
| BOYCE, ANDRE D |              |
| ART UNIT       | PAPER NUMBER |
| 3623           |              |

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                     |  |
|------------------------------|-------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/476,711 | Applicant(s)<br>MCGOVERAN, DAVID O. |  |
|                              | Examiner<br>Andre Boyce       | Art Unit<br>3623                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.  
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 112-190 and 192 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 112-190 and 192 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

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**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_

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Art Unit: 3623

## DETAILED ACTION

### *Response to Amendment*

1. This Final office action is in response to Applicant's amendment filed May 25, 2006. Claims 112 and 192 have been amended. Claim 191 has been canceled. Claims 112-190 and 192 are pending.
2. The previously pending rejections to claims 112-192 under 35 U.S.C. 112, second paragraph, have been withdrawn.
3. Applicant's arguments filed May 25, 2006 have been fully considered but they are not persuasive.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:  

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 112-190 and 192 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Here, the result of the invention lacks concreteness, since the result is not assured and reproducible, as discussed below. As such, the

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invention cannot be used as intended without undue experimentation, and is therefore not enabled.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 112-190 and 192 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In order to be considered useful, the claimed invention must possess a specific, substantial, and credible utility. In order to be concrete, the result must be assured and reproducible. In order to be tangible, the invention must provide a real world result and must involve more than a manipulation of an abstract idea.

In the present case, independent claims 112 and 192 provide no concrete result. Claim 112 recites declaring and stating an objective, declaring and stating at least one objective rule set, delegating to at least one specific set of actors, determining the satisfaction of an rule's condition, modifying at least on element, etc. However, the claimed invention is merely a "reasoning paradigm," (i.e., theoretical approach/roadmap) as described by Applicant, and produces no concrete result. Moreover, this reasoning paradigm (i.e., claimed invention) is subjective, whereby the result is neither assured nor repeatable. Claims 113-190 are rejected based

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upon the same rationale. Claim 192 recites means for accepting, comparing, delegating, determining, modifying, etc. However, these limitations provide no concrete result, since the result cannot be assured or reproduced, as discussed above.

### ***Response to Arguments***

8. In the Remarks, Applicant argues that the totality of claims 112 and 192, including executing automatically at least a subset of the dynamic pattern of operations that progresses towards said objective, and means for using said set of steps to further the attainment of a goal, respectively, effect a useful, concrete, and tangible result. The Examiner respectfully disagrees and submits that as discussed above, Applicant's limitations provide a reasoning paradigm that provides no concrete result, i.e., the result cannot be assured or reproduced. In addition, the affidavit of Professor Bidgoll makes no mention of the concreteness of the invention, and is, in any event, just one of many factors with respect to the Examiner's determination of whether the invention is statutory under 35 USC § 101.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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Art Unit: 3623

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571) 272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the



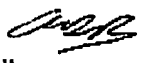
Page 6

Application/Control Number: 09/476,711

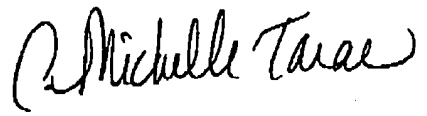
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automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-

272-1000.

  
adb  
August 7, 2006

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C. Michelle Tarae  
Patent Examiner  
Art Unit 3623

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In Re Application of: David O. McGovern  
Serial No. 09/476,711  
Filed: Dec. 30, 1999  
For: A Declarative Method

Examiner: Andre D. Boyce  
Group Art Unit: 3623  
Atty. Docket No: McG-003  
Date: Nov. 20, 2006

THE COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Arlington, VA 22313

SIR: Transmitted herewith is a Response to the Final Office Action dated 08/18/2006 for the above application.

☒ Small entity status for this application under 37 CFR §1.9 and 1.27 has been established by a verified statement previously submitted.

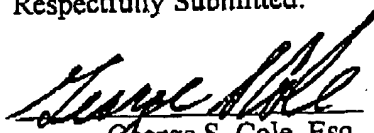
☐ Extension of time as necessary is requested and a payment for the required fee is enclosed.

☒ The Commissioner is hereby authorized to charge payment of any necessary fees, or credit any overpayment, to Deposit Account 50-0705 associated with this communication for any related purpose, including: ( A DUPLICATE COPY OF THIS SHEET IS ENCLOSED)

☐ Any additional filing fees required for presentation of extra claims

☒ Any extension or petition fees.

Respectfully Submitted:

  
George S. Cole, Esq.  
PTO #40,563

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In Re Application Of: David O. McGoveran  
Serial No. 09/476,711  
Filed: Dec. 30, 1999  
For: A Declarative Method

Examiner: Andre D. Boyce  
Group Art Unit: 3623  
Atty. Docket No: McG-003  
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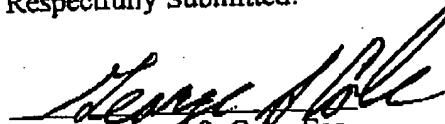
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☒ Any additional filing fees required for presentation of extra claims

☒ Any extension or petition fees.

Respectfully Submitted:

  
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